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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,985	06/25/2003	Michael W. Barrett	D/A3037	3847

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XEROX CORPORATION
100 CLINTON AVE., SOUTH, XEROX SQUARE, 20TH FLOOR
ROCHESTER, NY 14644

EXAMINER

WILLIAMS, KIMBERLY A

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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01/31/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/603,985

Applicant(s)

BARRETT ET AL.

Examiner

Kimberly A. Williams

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-9, 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 5, 9 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This application is responsive to an amendment filed 11/19/07. Claims 1-3 and 5-12 are pending.

Response to Arguments

2. Applicant's arguments with respect to former claim 4, now incorporated into claim 1, have been considered but are moot in view of the new ground(s) of rejection. The 103 rejection in the previous office action of Eguchi et al. in view of well known prior art has been replaced with a 103 rejection of Eguchi et al. in view of Watanabe.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3,6-8,11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eguchi et al. (US 20030117666) in view of Watanabe (US 20030164990).

Regarding claim 1, Eguchi et al. teaches a method for tracking facsimile jobs, comprising the steps of: (a) determining whether a return message (interpreted as an error message) is associated with the prepared message (interpreted as the original image data) that originated at the originating device (the CPU 2 determines that the

data received does not contain image data; fig. 6, step 52, para 48; fig. 12, steps 202 and 203, paras 68 and 69), and (b) in response to an affirmative determination in step (a), interpreting the return message as an incoming message not intended for printing and processing the return message according to a first predetermined configuration of the originating device (fig. 6, step 56 other processes; fig. 12, steps 208,209); whereby in response to a negative determination in step (b), an incoming message is interpreted as a valid message intended for printing and is processed according to a second predetermined configuration of the originating device (fig. 6, step 54).

Eguchi et al. do not specifically disclose that the return message is not printed. The Examiner takes official notice of the fact that it is known in the art to disallow printing an error message because it would be a waste of resources (e.g., consumables). Watanabe teaches a facsimile apparatus (1), compliant with two delivery confirmation mails, having a CPU (11) that controls a print control section (para. 39). Upon receiving delivery confirmation e-mails the CPU executes delivery confirmation mail processing (fig. 5, para 55), wherein a user may arbitrarily set as the print setting to the "never" setting (para 62,63,69). Eguchi's print and display setting could be modified with the print setting as taught by Watanabe. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the print setting of Watanabe for the purpose of saving resources.

Regarding claim 2, Eguchi teaches the step of detecting the presence of information indicative of the error condition in the return message (an error e-mail is received that informs the fax of the error; para 48, last sentence).

Regarding claim 3, Eguchi teaches the display (10a) and/or printer(9) reads on the error reporting mechanism.

Regarding claims 6-8, Eguchi teaches the facsimile device (1) has communication capabilities over a PSTN(13) or LAN(14).

Regarding claims 11 and 12, Eguchi teaches the return message is in the form of MDN or DSN (fig. 12, step 202).

Allowable Subject Matter

5. Claims 5,9 and 10 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

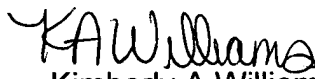
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly A. Williams whose telephone number is (571) 272-7471. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Kimberly A Williams
Primary Examiner
Art Unit 2625

KAW
January 23, 2008